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10/584,727	06/23/2006	Itsuo Sakakibara	292583US0PCT	6079
22850 7590 04/16/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER MATTISON, LORI K				
ART UNIT		PAPER NUMBER		
1619				
NOTIFICATION DATE		DELIVERY MODE		
04/16/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary**Application No.**

10/584,727

Applicant(s)

SAKAKIBARA, ITSUO

Examiner

LORI MATTISON

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/20/2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 9-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 06/23/2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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DETAILED ACTION

The Group and/or Art Unit location of your application in the PTO has changed.

All correspondence regarding this application should be directed to Group Art
Unit 1619.

Status of Claims

Claims 1-10 are pending in the current application, of which claims 1-8 are being considered on their merits. Claims 9 and 10 are withdrawn from consideration at this time.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-8, drawn to a hair cosmetizer which comprises a cosmetic material which comprises an oily material and a water soluble organic medium.

Group II, claim(s) 9 and 10, method of making hair cosmetizer which comprises cosmetic material which comprises oily material and a water soluble organic medium.

The inventions listed as Groups I and II, do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack

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the same or corresponding special technical features for the following reasons: they do not share the same structural element(s) that define the "special technical feature" necessary to specify a contribution over the prior art. The structural moiety, element, or step common to Groups I-II is the cosmetizer which comprises a cosmetic material which comprises an oily material and a water soluble organic medium, which are known in the art [see US Patent No. 5,1924,260 (Grollier, 1993)]. Example 11 of Grollier discloses the limitations of instant claim 1 (column 19, lines 35-60). Example 11 discloses a composition, "Composition B" (i.e. a cosmetic material), which comprises carnauba wax (i.e. an oily material which is solid at ordinary temperature), a water soluble organic medium (i.e. polyoxyethylenated glycerol monostearate; column 19, lines 35-60), and water (column 19, lines 35-60) which is taught to form a stable microdispersion of particles consisting essentially of wax or a mixture of waxes (abstract; column 1, lines 60-end; column 2, lines 1-15). The stable wax microdispersion (i.e. cosmetic material), "Composition B," is utilized in a hair cosmetizer in Example 11 (column, lines 15-25). Composition B is the major component of Example 11 which is dispersed with water (column 19, lines 35-60). Since the hair cosmetizer was already known in the art, it therefore, cannot be said to be the special technical feature that makes a contribution over the prior art. All other structural moieties, elements, or steps differ materially from one another. Thus, these claims lack the corresponding special technical feature(s) necessary to link them together to fulfill the Unity of Invention requirement.

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Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

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In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01

Applicant's election with traverse of claims 1-8, in the reply filed on 02/20/2009 is acknowledged. The traversal is on the ground(s) that the examiner has not considered that the claims are considered as related inventions under 37 C.F.R. § 1.475(b) (Reply, page 2, last paragraph). Applicant also asserts that unity of invention is present because the product prepared by Group II is dissolved or dispersed prior to applying to hair. Hence, the claims are drawn to a product and process for preparation of the said product (Reply, page 3,

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paragraph 1). Applicant also asserts that there is no search burden on the examiner as prescribed by M.P.E.P. § 803 and points out to the International Search Authority has searched all the claims and provided no evidence that restriction should be required (Reply, page 3, paragraph 5).

The examiner disagrees and finds applicant's traversal unpersuasive because the claims of the instant application do not fulfill the requirement of unity of invention under PCT Rules 13.1 and 13.2 (M.P.E.P. § 1850). The groups of invention (i.e. Group I and Group II) lack a technical relationship involving one or more of the same corresponding special technical features (PCT Rule 13.2; M.P.E.P. § 1850). The search report from the International Search Authority provides evidence that restriction should be required by citing 11 X-references which demonstrate that the invention is known and can not be considered as novel or involving an inventive step. Thus, the groups of the instant application do not share a special technical feature and the requirement for unity of invention is not satisfied.

With regard to the search burden, M.P.E.P. § 1850 clearly states "that when the Office considers international applications as an International Searching Authority, as an International Preliminary Examining Authority, and during the national stage as a Designated or Elected Office under 35 U.S.C. 371, PCT Rule 13.1 and 13.2 will be followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. 111." "In applying PCT Rule 13.2 to international applications as an International Searching Authority, an International

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Preliminary Examining Authority and to national stage applications under 35 U.S.C. 371, examiners should consider for unity of invention all the claims to different categories of invention in the application and permit retention in the same application for searching and/or preliminary examination, claims to the categories which meet the requirements of PCT Rule 13.2.” Since PCT Rule 13.2, and *not* search burden under M.P.E.P. § 803, is the basis for restriction between categories in national stage applications under 35 U.S.C. 371, applicant's arguments regarding search burden is moot in light of a demonstrated lack of unity of invention under PCT Rule 13.2. However, even if application of M.P.E.P. § 803 were appropriate; the lack of special technical feature in all of the claims creates a serious search burden since there is no unifying concept/feature shared among the claims. The direction provided by M.P.E.P. § 1850 regarding restriction among claims which demonstrate a lack of unity is clear and the Office is not required to follow the examination strategy of the International Search Authority when lack of unity of invention is present.

Claims 9 and 10 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 02/20/2009. Examination on the merits will commence on claims 1-8 ONLY.

Specification

Applicant is reminded of the proper content of an abstract of the disclosure.

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A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

The abstract of the disclosure is objected to because it is too long. The abstract is 174 words long rather than the required 150 words. Correction is required. See MPEP § 608.01(b).

Claim Objections

Claim 2 is objected to because of the following informalities: a space is needed between "claim" and "1." Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "ordinary temperature" in claims 1 and 5 is term which renders the claim indefinite. In the instant case is unclear as to what degree the temperature must be to be extraordinary.

Claims 1 and 5 recite "and a water soluble organic medium is the major component." It is unclear whether as to what the water soluble medium constitutes the major component. The metes and bounds of "major component" are also unclear. Furthermore, the relationship of "major component" as recited by claims 1 and 5 to other reagents in the composition appears to be contradictory with respect to instant claims 4 and 8 wherein the water soluble organic medium is present in an amount less than or equal to the oily material, suggesting that the water soluble organic medium is a minor component with respect to the oily material. Clarification is required.

Claim 1 recites the term "it." It is unclear was to whether "it" refers to the water soluble organic medium, the cosmetic material, or the hair cosmetizer.

Because claims 2-4 depend from indefinite claim 1 and claims 6-8 depend from indefinite claim 5 and do not clarify the point of confusion, they must also be rejected under 35 U.S.C. 112, second paragraph.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5, 7 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 6,302,920 (Lorenz, 2001).

Example 11 of Lorenz discloses an equivalent composition (column 7, lines 1-35). The composition is a hair bleach (i.e. a hair cosmetizer) which comprises a bleaching powder agglomerate (i.e. cosmetic material which is powdery). The cosmetic material comprises an oily material (i.e. polyethylene glycol wax) which is a solid at ordinary temperature and a water soluble organic medium, sodium carboxymethyl cellulose in a ratio of 5.5:1. Lorenz discloses that the bleaching powder agglomerate is easily miscible in a 9 % hydrogen peroxide solution (i.e. a solution which comprises 9% hydrogen peroxide and 91% water), thus disclosing that the powder composition dissolves into the water containing solution.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which

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said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,302,920 (Lorenz, 2001) in view of US Patent No. 5,002,761 (Mueller, 1991).

The limitations of 1-5, 7 and 8 are addressed above. Lorenz teaches that inclusion of low quantities of surfactant increase the handling properties of the hair bleach (i.e. cosmetic material; column 2, lines 60-65). When the powder acts as a dyeing powder, Lorenz teaches a "natural" composition by teaching use of natural dyestuffs (column 3, lines 20-35).

Lorenz does not teach that the oily material is rosin as set forth in instant claim 6.

Mueller teaches that abietic acid (i.e. rosin acid) is a natural emulsifier which may be used in hair compositions (column 3, lines 30-35).

It would have been *prima facie* obvious to a person of ordinary skill in the art at the time the invention was made to have optimized the composition of Example 11 taught by Lorenz through routine experimentation to include rosin

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(i.e. abietic acid) because Lorenz teaches that a small amount of surfactant improves the handling properties of the hair bleaching composition and abietic acid (rosin) is a natural surfactant suitable for hair compositions as taught by Mueller. The skilled artisan would have been motivated to do so in order to improve the handling properties of the composition through use of a "natural" surfactant ingredient as taught by Lorenz.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LORI MATTISON whose telephone number is (571)270-5866. The examiner can normally be reached on 8am-6pm (Monday-Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571)272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. M./

Examiner, Art Unit 1619

/MP WOODWARD/
Supervisory Patent Examiner, Art Unit 1615